

Remarks

Claims 1-45 are pending. Claims 1 and 24 are amended for clarity.

The Examiner rejected Claims 1-45 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Applicant disagrees with the Examiner because the claims each recite a system including well-known computer components. Nevertheless, to expedite prosecution, Applicant has amended Claim 1 to recite a processor, which is clearly capable of causing functional changes in the computer. Reconsideration and allowance of Claims 1-45 are therefore requested.

The Examiner rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 20060041505 ("Enyart"), in view of U.S. Patent Application Publication 20070083438 ("Coleman"). The Examiner states:

Enyart disclosed (i.e., Claim 1) a system comprising: a subscriber profile database including electronic addresses (Enyart-Paragraph 2, 'database including a registry of possible message recipients'); and a electronic address directory for retrieving from the subscriber profile database electronic addresses of selected subscribers. (Enyart-Paragraph 55, 'select list of recipients')

While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re claim 1) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile.

The Examiner notes that at the time of the invention email systems implementing permission-based direct email marketing was well-known in the networking art (See Lanzillo US 2002/00322602).

Furthermore the use of search criterion for selecting targeted recipients was also well-known in the networking art. Furthermore the use of databases and search/retrieval facilities were well-known in the networking art. (See Weitzman US Publication 2002/0099605).

The methods for matching potential buyers with targeted advertisements were well-known in the art. (See Coleman US Publication 20070083438).

The Examiner notes that in permission-based email exchanges where a receiver is allowed to opt-in to receive messages only from specified sources it would have been obvious for a sender to specify a search criterion for selecting users with indicated preferences.

Furthermore Coleman disclosed (re. Claim 1) selecting subscribers based on a search criterion selecting a specified biographical or affinity profiles (Coleman-Paragraph 20-21, Paragraph 58, 'advertisements may be presented to only certain potential purchasers who meet requirements set by the advertiser')

Enyart and Coleman are analogous art because they present concepts and practices regarding email systems implementing permission-based direct email marketing. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Coleman into Enyart. The motivation for said combination would have been to enable aggregating a pool of purchasers for linking to sellers. (Coleman-Paragraph 9)

As amended, Claim 1 is amended to recite that the system includes a transaction tracking system that tracks responses to a subscriber's registration messages:

1. A system comprising:

a subscriber profile database including electronic addresses and biographical and affinity information of subscribers to the system;

a transaction tracking service which tracks responses to each subscriber's registration messages; and

a processor which operates the transaction tracking service and an electronic address directory; wherein, in response to a query of the electronic address directory, the processor retrieves from the subscriber profile database electronic addresses of selected subscribers based on a search criterion selecting a specified biographical or affinity profile.

(emphasis added)

The above-underscored limitation, which was previously recited in Claim 24, is

neither disclosed nor suggested by Enyart or Coleman. In the Examiner's rejection of Claim 24, the Examiner contends that the the limitation was disclosed by Enyart's paragraph 1128. However, Enyart's paragraph 1128 merely discloses providing summary statistics of all communications:

[1128] Provide trending in n-minute intervals, of summary statistics of all sent and received communications.

Such summary statistics do not "[track] responses to a subscriber's registration messages," therefore Enyart's teaching fails to meet the limitations of Claim 1. Furthermore, as discussed in Applicants' Specification, at page 10, lines 14-16, such transaction service provides benefits to both the specific subscriber whose registration message responses are being track and the potential advertisers:

According to one embodiment of the present invention, a transaction tracking service detects incoming registration or order confirmation eMail messages to avoid mistakenly rejecting such messages as spam and to learn the online shopping behavior of the member. The member's shopping behavior is valuable information to potential advertisers.

Thus, Applicants' respectfully submit that Claim 1, and its dependent Claims 2-10 and 13, are each unobvious and thus allowable over the combined teachings of Enyart, Coleman and Goodwin. Reconsideration and allowance of Claims 1-10 and 13 are therefore requested.

The Examiner rejected Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, and further in view of U.S. Patent Application 2006/0229934 ("Law"). The Examiner states:

The Examiner notes that Enyart (Enyart-Paragraph 42, Paragraph 645) disclosed email forwarding.

While Enyart-Coleman substantially disclosed the claimed invention EnyartColeman did not disclose (re. Claim 11) wherein a subscriber specifies an out-ofservice electronic

address and a current electronic address to which electronic messages addressed to the out-of-service address are forwarded.

The Examiner notes that at the time of the invention alternate address forwarding was well-known in the networking art. (See Fuisz US Patent 7188144)

Furthermore Law disclosed (re. Claim 11) wherein a subscriber specifies an outof-service electronic address and a current electronic address to which electronic messages addressed to the out-of-service address are forwarded. (Law-Paragraph 23,' temporary reroute messages instruction may be utilized by the recipient 180 when the recipient 180 wished to have messages sent to an alternate address')

Enyart,Coleman and Law are analogous art because they present concepts and practices regarding email systems implementing permission-based direct email marketing. (Law-Paragraph 30) At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Law into Enyart-Coleman. The motivation for said combination would have been (Law-Paragraph 9) to enable a more efficient and effective process for senders to provide recipients with messages.

Applicant respectfully traverses the Examiner's rejection. Claim 11 depends from Claim 1 and thus is allowable over the combined teachings of Enyart and Coleman for the reasons already stated above. As Law does not cure the deficiency of the combined teachings of Enyart and Coleman (i.e., Law neither discloses nor suggests Claim 1's transaction tracking service), Claim 11 is allowable over the combined teachings of Enyart, Coleman and Law. Reconsideration and allowance of Claim 11 are therefore requested.

The Examiner rejected Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, further in view of Law, and further in view of U.S. Patent 6,959,324 ("Kubik"). The Examiner states:

While Enyart-Coleman-Law substantially disclosed the claimed invention EnyartColeman-Law did not disclose (re. Claim 12) electronic message forwarding service allowing sending electronic messages to the electronic addresses retrieved, wherein the electronic message forwarding service

verifying the out-of-service address by sending probing messages addressed to the out-of-service address from time to time to elicit a unsuccessful delivery reply.

The Examiner notes that at the time of the invention testing for inactive email addresses was well-known in the networking art. It was well-known to have email providers send an unsuccessful delivery reply.

Furthermore Kubik disclosed (re. Claim 12) electronic message forwarding service allowing sending electronic messages to the electronic addresses retrieved, wherein the electronic message forwarding service verifying the out-of-service address by sending probing messages (Kubik-Column 6 Lines 50-65, *'e-mail tester program 512, which tests e-mail addresses to determine whether addresses are valid or invalid.'*) addressed to the out-of-service address from time to time to elicit a unsuccessful delivery reply. (Kubik-Column 1 Lines 35-40)

Enyart, Coleman, Law, and Kubik are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kubik into Enyart-Coleman-Law. The motivation for said combination would have been (Law- Paragraph 9) to enable a more efficient and effective process for senders to provide recipients with messages.

Applicant respectfully traverses the Examiner's rejection. Claim 12 depends from Claim 11 and thus is allowable over the combined teachings of Enyart, Coleman and Law for the reasons already stated above. As Kubik does not cure the deficiency of the combined teachings of Enyart, Coleman and Law (i.e., Kubik neither discloses nor suggests Claim 1's transaction tracking service), Claim 12 is allowable over the combined teachings of Enyart, Coleman, Law and Kubik. Reconsideration and allowance of Claim 12 are therefore requested.

The Examiner rejected Claims 14-21, 24-26, 31-33, and 37-45 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, and further in view of U.S.

Patent Application Publication 2003/0163485 ("Goodwin"). With respect to Claims 14, 24, 31 and 37, the Examiner states:

The Examiner notes that Enyart disclosed a public directory for contacting users. (Enyart-Paragraph 1005-1006)

While Enyart-Coleman substantially disclosed the claimed invention Enyart-Coleman did not disclose (re. Claim 14) wherein the database further comprises information of interest to the subscribers.

Goodwin disclosed (re. Claim 14) wherein the database further comprises information of interest to the subscribers. (Goodwin-Paragraph 55, Paragraph 72)

Enyart, Coleman and Goodwin are analogous art because they present concepts and practices regarding email systems for users with the same affinity. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Goodwin into Enyart-Coleman. The motivation for said combination would have been to provide relevant information about the user's field of interest and also to indicate a user's affinity to the general public. (Goodwin-Paragraph 4, Paragraph 16, Paragraph 74)

* * *

Enyart-Coleman-Goodwin disclosed (re. Claim 24) a transaction tracking service which tracks responses to a subscriber's registration messages (Enyart-Paragraph 1128) and responses and collect information regarding subject matters of the subscriber's registrations messages.

* * *

Enyart-Coleman-Goodwin disclosed (re. Claim 31) wherein the sender's fee levied on an electronic message for each subscriber is specified by the subscriber. (Enyart-Paragraph 74)

* * *

Enyart-Coleman-Goodwin disclosed (re. Claim 37) a content search gateway (Goodwin-Paragraph 145) which enables a subscriber to search for information in one or more information resources using a query, wherein the content search gateway processes both the query and the result of the search to update affinity information of the subscriber in the subscriber profile database. (Goodwin-Paragraph 150, *'maintain profile and affinities'*)

Applicant respectfully traverses the Examiner's rejection. Claims 14, 24, 31 and 37 each depend directly or indirectly from Claim 1 and thus are each allowable over the combined teachings of Enyart, Coleman and Goodwin for the reasons already stated above. In turn, Claims 15-21, 25-26, 32-33 and 38-45 each depend from their respective parent Claims 14, 24, 31 and 37. Reconsideration and allowance of Claims 14-21, 24-26, 31-33 and 37-45 are therefore requested.

The Examiner rejected Claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, in view of Goodwin and further in view of U.S. Patent Application Publication 2005/0055321 ("Fratkina"). The Examiner states:

The Examiner notes that Goodwin disclosed (Goodwin-Paragraph 118) determining the frequency of cluster terms.

While Enyart-Coleman-Goodwin substantially disclosed the invention, Enyart-Coleman-Goodwin did not disclose (re. Claim 22) wherein queries to retrieved the information of interest and responses to the queries are selectively included in a frequently asked questions database.

The Examiner notes that the FAQ databases and methods for maintaining the FAQ database, including feedback information are well-known in the networking art.

Furthermore Fratkina disclosed (re. Claim 22) wherein queries to retrieved the information of interest and responses to the queries are selectively included in a frequently asked questions database. (Fratkina-Paragraph 335,' report showing frequently asked questions')

At the time of the invention it would have been obvious to combine the teachings of Fratkina regarding FAQ databases into Enyart-Coleman-Goodwin. The motivation for said combination would have been to model the way an expert elicits information. (Fratkina-Paragraph 10)

Enyart-Coleman-Goodwin-Fratkina disclosed (re. Claim 23) wherein the frequently asked questions database is improved by subscribers provided feedback. (Fratkina-Paragraph 11, Paragraph 336)

Applicant respectfully traverses the Examiner's rejection. Claims 22-23 each depend from Claim 14 and thus is allowable over the combined teachings of Enyart, Coleman and Goodwin for the reasons already stated above. As Fratkina does not cure the deficiency of the combined teachings of Enyart, Coleman and Goodwin (i.e., Fratkina neither discloses nor suggests Claim 1's transaction tracking service), Claims 22-23 are each allowable over the combined teachings of Enyart, Coleman, Goodwin and Fratkina. Reconsideration and allowance of Claims 22-23 are therefore requested.

The Examiner rejected Claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, in view of Goodwin and further in view of U.S. Patent Application Publication 2004/0201625 ("Karamchedu"). The Examiner states:

While Enyart-Coleman-Goodwin substantially disclosed the claimed invention Enyart-Goodwin did not disclose (re. Claim 34) wherein the electronic message mailbox service allows a subscriber to specify a daily maximum limit on the number of eMail messages that is received from unsolicited sources.

Karamchedu disclosed (re. Claim 34) wherein the electronic message mailbox service allows a subscriber to specify a daily maximum limit on the number of eMail messages that is received from unsolicited sources. (Karamchedu-Figure 3, Paragraph 22)

Enyart, Coleman, Goodwin, Karamchedu are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Karamchedu into Enyart-Coleman-Goodwin. The motivation for said combination would have been to prevent loss in productivity due to undesired email. (Karamchedu-Paragraph 3)

Applicant respectfully traverses the Examiner's rejection. Claim 34 depends from Claim 33 and thus is allowable over the combined teachings of Enyart, Coleman and Goodwin for the reasons already stated above. As Karamchedu does not cure the deficiency of the combined teachings of Enyart, Coleman and Goodwin (i.e., Karamchedu neither

discloses nor suggests Claim 1's transaction tracking service), Claim 34 is allowable over the combined teachings of Enyart, Coleman, Goodwin and Karamchedu. Reconsideration and allowance of Claim 34 are therefore requested.

The Examiner rejected Claims 27-30 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, in view of Goodwin and further in view of U.S. Patent 7,280,982 ("Moskowitz"). With respect to Claim 27, the Examiner states:

While Enyart-Coleman-Goodwin substantially disclosed the claimed invention Enyart-Coleman-Goodwin did not disclose (re. Claim 27) wherein the electronic route-through service retrieves electronic messages from a subscriber's public mailbox, processes the retrieved electronic messages by a subscriber-specified service, and forwards the processed electronic messages to the subscriber's private mailbox.

The Examiner notes that at the time of the invention, alternate address forwarding for public and private mailboxes was well-known in the networking art.

Furthermore Moskowitz disclosed (re. Claim 27) wherein the electronic route-through service retrieves electronic messages from a subscriber's public mailbox, processes the retrieved electronic messages by a subscriber-specified service, and forwards the processed electronic messages to the subscriber's private mailbox. (Moskowitz-Column 2 Lines 30-50)

Enyart, Coleman, Goodwin, and Moskowitz are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Moskowitz into Enyart-Coleman-Goodwin. The motivation for said combination would have been to protect the privacy of the user's personal mailbox. (Moskowitz-Column 2 Lines 35-40)

Applicant respectfully traverses the Examiner's rejection. Claims 27-30 each depend from Claim 26 and thus is allowable over the combined teachings of Enyart, Coleman and Goodwin for the reasons already stated above. As Moskowitz does not cure the deficiency of the combined teachings of Enyart, Coleman and Goodwin (i.e., Moskowitz neither discloses

nor suggests Claim 1's transaction tracking service), Claims 27-30 are each allowable over the combined teachings of Enyart, Coleman, Goodwin and Moskowitz. Reconsideration and allowance of Claims 27-30 are therefore requested.

The Examiner rejected Claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, in view of Goodwin and further in view of Moskowitz. The Examiner states:

While Enyart-Coleman substantially disclosed the claimed invention EnyartColeman did not disclose (re. Claim 35) wherein the electronic message forwarding service sends a sender of electronic message not accompanied by a sender's fee an invoice for the sender's fee, and defers forwarding the electronic message until the invoice is paid.

The Examiner notes that Enyart disclosed (Enyart-Paragraph 570) of notifying the sender for insufficient postage and holding email in the Post Office Dumpster (Enyart-Paragraph 572). Enyart also disclosed (Enyart-Paragraph 579) holding mail delivery until the recipient pays a fee to retrieve the email from the dumpster.

It would have been an obvious variation of Enyart to wait for the sender to pay the postage fee before forwarding the email to the recipient.

Furthermore Moskowitz disclosed (re. Claim 35) wherein the electronic message forwarding service sends a sender of electronic message not accompanied by a sender's fee an invoice for the sender's fee, and defers forwarding the electronic message until the invoice is paid. (Moskowitz-Column 3 Lines 20-30)

Enyart, Coleman and Moskowitz are analogous art because they present concepts and practices regarding email systems. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Moskowitz into Enyart-Coleman. The motivation for said combination would have been to allow for settlement/clearinghouse procedures to be implemented for large (sender) accounts.

Applicant respectfully traverses the Examiner's rejection. Claim 35 depends from

Claim 4 and thus is allowable over the combined teachings of Enyart, Coleman and Goodwin for the reasons already stated above. As Moskowitz does not cure the deficiency of the combined teachings of Enyart, Coleman and Goodwin (i.e., Moskowitz neither discloses nor suggests Claim 1's transaction tracking service), Claim 35 is allowable over the combined teachings of Enyart, Coleman, Goodwin and Moskowitz. Reconsideration and allowance of Claim 35 are therefore requested.

The Examiner rejected Claim 36 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, in view of Goodwin and further in view of U.S. Patent Application Publication 2005/0004837 ("Sweeney"). The Examiner states:

While Enyart-Coleman-Goodwin determining when an electronic message sent to one of the electronic addresses retrieved is unread after a specified time period, Enyart-Coleman-Goodwin did not disclose (re. Claim 36) wherein the subscriber search gateway further enables the sender to redirect said electronic message sent to another one of the electronic addresses retrieved.

Furthermore Sweeney disclosed (re. Claim 36) redirecting email advertising to a second selected recipient if the first recipient is not interested in the sender's email. (Sweeney-Paragraph 35-37, *'Compound affiliated e-mail marketing'*)

The Examiner notes that at the time of the invention the process of redirecting and forwarding emails was well-known in the networking art. Furthermore at the time of the invention where Enyart disclosed a list of potential business contacts, it would have been obvious to try each one of the potential contacts until one of the potential contacts agrees to the business offering.

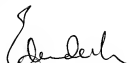
Enyart-Coleman-Goodwin and Sweeney are analogous art because they present concepts regarding email systems implementing permission-based direct email marketing. Thus at the time of the invention it would have been obvious to combine Sweeney into Enyart-Coleman-Goodwin. The motivation for said combination would have been (Sweeney-Paragraph 22) to enable a viral, self-propagating way to reach an entire community of interest, and only that community of interest.

Thus Enyart-Coleman-Goodwin-Sweeney disclosed (re. Claim 36) wherein the subscriber search gateway further enables the sender to redirect when an electronic message sent to one of the electronic addresses retrieved is unread after a specified time period to another one of the electronic addresses retrieved.

Applicant respectfully traverses the Examiner's rejection. Claim 36 depends from Claim 32 and thus is allowable over the combined teachings of Enyart, Coleman and Goodwin for the reasons already stated above. As Sweeney does not cure the deficiency of the combined teachings of Enyart, Coleman and Goodwin (i.e., Sweeney neither discloses nor suggests Claim 1's transaction tracking service), Claim 36 is allowable over the combined teachings of Enyart, Coleman, Goodwin and Sweeney. Reconsideration and allowance of Claim 36 are therefore requested.

Therefore, for the reasons discussed above, all pending claims (i.e., Claims 1-45) are believed allowable. If the Examiner has any question regarding the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant at (408)-392-9250.

Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's electronic filing system on June 5, 2008.




Attorney for Applicant(s)

6/5/2008

Date of Signature

Respectfully submitted,


Edward C. Kwok
Attorney for Applicant(s)
Reg. No. 33,938

Law Offices of
MacPherson Kwok Chen & Heid LLP
2033 Gateway Place, Suite 400
San Jose, CA 95110
Tel: (408) 392-9250
Fax: (408) 392-9262